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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,965	07/28/2003	Kenichi Hirota	DAIN:742	2268
6160	7590	04/11/2005	EXAMINER	
PARKHURST & WENDEL, L.L.P. 1421 PRINCE STREET SUITE 210 ALEXANDRIA, VA 22314-2805			HESS, BRUCE H	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/627,965

Applicant(s)

HIROTA ET AL.

Examiner

Bruce H Hess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1-16-04 (IDS)
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/007)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Report No(s) Mail Date 1-16-04

1. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

2. Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the patents to Oshima et al (USP 5,427,997) or Hayashi et al (EP 1,179,753).

These patents teach a matted print comprising a sublimation dye image and a protective layer which has been transferred from a protective layer thermal transfer sheet comprising a substrate, a release layer containing resin and filler and a protective layer. The particles provide a roughened release surface, which is imparted to the protective layer. The experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine the size of the filler) fails to render applicants' claims patentable in the absence of unexpected results.

3. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by the patent to Oshima et al.

4. Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the patents to Onishi et al (USP 6,413,687) in view of the patent to Oshima et al.

The primary patents teach sublimation dye image print protective layer thermal transfer sheet comprising a substrate, a release layer comprising resin and filler and a protective layer. Oshima et al teach that a matted print can be obtained by adding extra

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filler to the release layer of a protective layer thermal transfer sheet. Given the desirability of a mat print, use of extra filler in the release layers of the primary references as taught by the secondary reference would have been obvious to one of ordinary skill in this art in the absence of unexpected results.

Any inquiry concerning this communication should be directed to Bruce Hess at telephone number (571) 272-1525.

B. Hess/dh  
April 4, 2005

A handwritten signature in black ink, appearing to read "Bruce Hess", with a stylized flourish at the end.

BRUCE H. HESS  
PRIMARY EXAMINER  
GROUP 1300